

Remarks

I. Status of the Claims

Claims 1-299 are pending in this application. Claims 282-285 and 287 have been withdrawn from consideration by the Examiner. No claims have been amended herein.

II. Rejection under 35 U.S.C. § 103(a)

Claims 1-281, 286, and 288-299 stand rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,302,378 ("*Crotty*") in view of U.S. Patent No. 5,783,657 ("*Pavlin*") and further in view of U.S. Patent No. 6,165,454¹ ("*Patel*") for the reasons set forth on pages 3-4 of the Office Action dated July 19, 2002, as well as those set forth on pages 2-3 of the present Office Action. Applicants respectfully continue to traverse this rejection.

Two of the basic criteria an Examiner must demonstrate in order to establish a prima facie case of obviousness are (1) that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, and (2) that there is a reasonable expectation of success in making the proposed modification. See M.P.E.P. § 2143. Neither of these two criteria has been satisfied with respect to the modifications of *Crotty* proposed by the Examiner.

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¹ Applicants presume that the Examiner meant U.S. Patent No. 6,165,454, issued to Patel, as cited in the Office Action of July 19, 2002. Applicants request clarification if this presumption is not correct.

A. There would have been no suggestion or motivation to modify *Crotty* or to combine the teachings of the cited references as proposed by the Examiner

With respect to the first criterion, the Federal Circuit has recently stated that:

[t]he factual inquiry whether to combine references must be thorough and searching. It **must be based on objective evidence of record....** Thus the Board must not only assure that the requisite findings are made, based on evidence of record, **but must also explain the reasoning by which the findings are deemed to support the agency's conclusion.**

See In re Lee, 61 U.S.P.Q.2D (BNA) 1430 (Fed. Cir. 2002) (emphasis added).

Further, “[t]o establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant.”

In re Kotzab, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d (BNA) 1313 (Fed. Cir. 2000).

Even when obviousness is based on a single prior art reference, there must be such a showing. See B.F. Goodrich Co. v. Aircraft Braking Sys. Corp., 72 F.3d 1577, 1582, 37 U.S.P.Q.2D (BNA) 1314, 1318 (Fed. Cir. 1996). Accordingly, the requirements discussed in In re Lee are equally applicable in cases where the Examiner proposes to modify a single reference. Moreover, the mere fact that references **can** be combined or modified does not render the resultant combination obvious unless the prior art **also suggests the desirability** of the combination. See M.P.E.P. § 2143.01.

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In the present case, the Examiner has failed to make a factual inquiry based on any objective evidence of record. Such an inquiry would reveal that there would have been no motivation to make the proposed modifications at the time the invention was made, as discussed below.

1. *Crotty* does not suggest the desirability of including an oil-soluble polymer chosen from alkyl celluloses and alkylated guar gums

The presently claimed invention requires at least one liquid fatty phase which comprises (i) at least one structuring polymer comprising a polymer skeleton which comprises at least one hydrocarbon-based repeating unit comprising at least one hetero atom and (ii) at least one oil-soluble polymer chosen from alkyl celluloses and alkylated guar gums. On the other hand, *Crotty's* compositions comprise a C₃-C₂₄ α -hydroxy substituted ketone or aldehyde, an anionic silicone copolyol, and a pharmaceutically acceptable vehicle. See col. 2, lines 22-29. The Examiner states that *Crotty's* "[c]omposition includes, sodium carboxyl methylcellulose, hydroxyalkyl cellulose etc. (col. 4, lines 49-61), polyethylene and polyamides (col. 5, line 33)." See page 3 of the Office Action dated July 19, 2002. However, none of the above are at least one oil-soluble polymer chosen from alkyl celluloses and alkylated guar gums.

Further, *Crotty* fails to provide the requisite motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant, for example, of including in *Crotty's* compositions at least one oil-soluble polymer chosen from alkyl celluloses and alkylated guar gums. In fact, *Crotty* merely

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discloses numerous optional ingredients, such as (1) propylene glycol; (2) dihydroxyacetone; (3) indole derivatives; (4) pharmaceutically acceptable vehicles; (5) thickeners/viscosifiers; (6) emulsifiers; (7) surfactants; (8) fatty acids; (9) sunscreen agents; (10) preservatives; (11) fragrances; (12) antifoam agents; (13) opacifiers; and (14) colorants. See col. 3, line 5 through col. 5, line 66.

Moreover, as Applicants pointed out in their previous response, *Crotty* fails to disclose or exemplify any composition comprising at least one oil-soluble polymer chosen from alkyl celluloses and alkylated guar gums. Although Applicants are well aware that “examples in a patent are for illustration [and]...do not limit the disclosed invention,” there is no teaching in *Crotty*, even apart from the examples, that suggests the desirability of selecting at least one oil-soluble polymer chosen from alkyl celluloses and alkylated guar gums, nor has the Examiner pointed to any, as he must to satisfy his burden.

Finally, *Crotty* actually **teaches away from** the modification the Examiner proposes. For example, *Crotty* discloses that “[w]ater is a preferred vehicle or carrier for the compositions of this invention.” See col. 3, lines 21-22. In contrast, the alkyl celluloses and alkylated guar gums of the present invention are oil-soluble.

Accordingly, for at least the foregoing reasons, a factual inquiry based on objective evidence of record fails to establish the requisite motivation, suggestion or teaching of the desirability of making the specific combination that was made by Applicants.

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2. There is no suggestion or motivation to combine the teachings of *Pavlin* and the teachings of *Crotty*

As discussed above, the factual inquiry whether to combine references must be thorough and searching, and must be based on objective evidence of record. See In re Lee, supra. In the present case, the Examiner's bare assertion that "it would have been obvious to include in the composition of *Crotty* (a) the specific polyamide of *Pavlin* in order to produce a transparent, gel-like cosmetic composition with desirable rheological properties" fails to satisfy In re Lee's heavy burden. Moreover, as previously discussed, the mere fact that references **can** be combined or modified does not render the resultant combination obvious unless the prior art **also suggests the desirability** of the combination. See M.P.E.P. § 2143.01. In the present case, the cited references do not suggest the desirability of the proposed combination, nor does the Examiner suggest **any** suggestion or motivation in the evidence of record to support the proposed combination.

Accordingly, for at least the foregoing reasons, the Examiner has failed to establish a prima facie case of obviousness and Applicants respectfully request that the rejection be withdrawn.

3. There is no suggestion or motivation to combine the teachings of *Patel* and the teachings of *Crotty*

The Examiner relies on *Patel* for the teaching of galactomannan gum, presumably because, according to the Examiner, "*Crotty* does not specifically mention the...gum of instant claim 64." See page 3 of the Office Action dated July 19, 2002.

In response to Applicants' assertion that *Patel* is drawn to hair care products, such as shampoos, whereas *Crotty* is drawn to self-tanning creams for the skin, the Examiner asserts that "*Patel* achieves stability by using a conditioning agent" and concludes that "the same agent should be equally useful to stabilize the composition of *Crotty*." See page 3 of the present Office Action. Applicants disagree.

First, nowhere does *Patel* disclose that stability is achieved by using a conditioning agent, as the Examiner alleges. Rather, *Patel* discloses a method of stabilizing water-insoluble organosilicone compounds to form a composition comprising, *inter alia*, a deterative surfactant, a water-insoluble conditioning agent optionally in a mixture with a cationic polymer, an acrylic stabilizing agent, and water or aqueous medium. See col. 2, line 35 through col. 3, line 17.

Second, nowhere does *Patel* attribute the stabilization of water-insoluble organosilicone compounds to the optional cationic polymer, let alone to galactomannan gum.

Third, the silicone in *Crotty*'s compositions is an anionic silicone copolyol and therefore is water soluble. See Abstract. As discussed above however, *Patel* discloses a method of stabilizing water-insoluble organosilicone compounds. Thus, even assuming, *arguendo*, that the stabilization in *Patel* was attributed to the optional cationic polymer, or even to galactomannan gum, the stabilization taught would be that of water-**insoluble** organosilicone compounds and not of water-**soluble** anionic silicone copolyol as in *Crotty*.

Accordingly, for at least the foregoing reasons, the Examiner's assertion that "the same agent should be equally useful to stabilize the composition of *Crotty*" is

simply untenable and Applicants respectfully request that the rejection be withdrawn. See In re Zurko, 59 U.S.P.Q.2d 1693, 1697 (Fed. Cir. 2001) (finding that unless there is "substantial evidence" found in the record to support the factual determinations central to the issue of patentability, the rejection is improper and should be withdrawn).

B. There would not have been a reasonable expectation of success in making the proposed combination of *Crotty* and *Pavlin*.

With respect to the second criterion the Examiner must demonstrate to establish a prima facie case of obviousness, *i.e.*, that there is a reasonable expectation of success in the proposed combination, the Examiner has again failed to meet his burden.

In the present case, *Crotty* and *Pavlin* actually teach away from the combination the Examiner proposes. For example, *Pavlin* teaches that the polyamide disclosed therein "may be blended with a liquid hydrocarbon to form a transparent composition having gel consistency." See Abstract. *Crotty* does not disclose the use of liquid hydrocarbons in its compositions and, in fact, teaches that "[w]ater is a preferred vehicle or carrier" for its compositions. See col. 3, lines 21-22 and Example 1. Accordingly, for at least this reason, the teachings of *Crotty* would have led the skilled artisan away from the combination the Examiner proposes, and therefore no reasonable expectation of success in the combination exists.

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In light of the foregoing, Applicants respectfully submit that the Examiner has failed to establish a prima facie case of obviousness, and thus, request that the rejections under 35 U.S.C. § 103(a) be withdrawn.

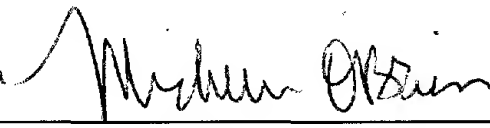
III. Conclusion

In view of the foregoing remarks, Applicants respectfully request the reconsideration of the pending claims, reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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